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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,553	12/18/2001	Audrey A. Sherman	56009 US002	2489

32692 7590 08/06/2004

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EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/028,553	SHERMAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Christopher M. Keehan	1712	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-8,10-21,23-36 and 38-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-21,23-36 and 38-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 112***

The rejection of claims 38 and 39 under 35 U.S.C. 112, second paragraph, has been withdrawn due to applicant's amendments.

#### ***Claim Rejections - 35 USC § 102/103***

The rejection of claims 1-3, 7, 10, 13-20, 22, 23, 27, and 29-45 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sherman et al. (WO 96/34028) has been maintained and is as set forth in the previous office action.

#### ***Claim Rejections - 35 USC § 103***

The rejection of claims 8, 11, 12, 21, and 28 under 35 U.S.C. 103(a) as being unpatentable over Sherman et al. (WO 96/34028) has been maintained and is as set forth in the previous office action.

The rejection of claims 4-6 and 24-26 under 35 U.S.C. 103(a) as being unpatentable over Sherman et al. (WO 96/34028) in view of Cifuentes et al. (5,776,614) has been maintained and is as set forth in the previous office action.

The rejection of claims 1-7, 10, 13-20, 22-27, and 29-45 under 35 U.S.C. 103(a) as being unpatentable over Sherman et al. (WO 96/34028) in view of Sweet et al. (4,882,377) has been maintained and is as set forth in the previous office action.

### ***Response to Arguments***

Applicant's arguments filed 7/1/04 have been fully considered but they are not persuasive. Applicant has argued that Sherman et al. fail to appreciate the problem of silicone tackifier migration when the silicone tackifying resin is provided at a concentration of at least 55 wt% silicone tackifying resin, based on the weight of the silicone tackifying resin and the polydiorganosiloxane polyurea copolymer, and applicant has amended claims 1, 18, 19, and 36 to include the limitation that the plasticizer is present in an amount sufficient to provide a generally uniform distribution of the polydiorganosiloxane polyurea copolymer and the silicone tackifying resin. However, as set forth in the last office action, applicant discloses that the plasticizer (processing aid) can be present in an amount of at least 0.5 wt% (specification, page 3, lines 4-9). Sherman et al. surely would have added the plasticizer in an amount included in this range, as it encompasses from 0.5 wt% to 100 wt%. Therefore, as set forth in the previous office action, the benefits of the plasticizer, as claimed by applicant, would have inherently occurred.

Applicant further argues that Sherman et al. do not teach or disclose the claimed polydiorganosiloxane polyurea copolymer, but rather a polydiorganosiloxane oligurea

segmented copolymers. It is the examiner's position that the formula of Sherman et al. can also include applicant's claimed formula (specification, page 6).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (571) 272-1087. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1712

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Keehan



August 3, 2004

DAVID J. BUTTNER  
PRIMARY EXAMINER

